

## REMARKS

The amendment previously filed on April 2, 2008 have been objected to by the Examiner under 35 U.S.C. § 132(a) on the grounds that it introduces new matter. Specifically, the Examiner has objected to the introduction of references to the “lamination stack” of the motor, and states that although it is reasonable and probable, it is neither inherent nor obvious that the previously unidentified portion of the drawing was a lamination stack. The Applicants respectfully disagree with the Examiner’s position, and request reconsideration of the objection to the previously filed amendment.

Initially, it is noted that the lamination stack, although not identified specifically, was clearly shown in the originally filed drawings, and therefore cannot be new matter. The standard for identifying new matter in an amendment is based upon whether the subject matter was disclosed in the originally filed specification, drawings, or claims. Thus, if the subject matter was disclosed in one of those parts of the application, then it is not new matter. In this case, the lamination stack was disclosed and shown in the originally filed drawings, and therefore is not new matter despite its absence from the originally filed specification and claims. The Applicants are not aware of any requirement that structural features clearly shown in the drawings must be positively identified or described in the specification in order to avoid a new matter rejection under 35 U.S.C. § 132(a). In fact, such a requirement would be contrary to the idea that the drawings form a part of the original disclosure. If only those drawing features that were positively identified in the specification were considered “disclosed”, as the Examiner seems to be suggesting, then the original disclosure would consist only of the specification, which is inconsistent with the current patent laws and regulations.

Furthermore, the specification and drawings, as originally filed, identify an electric motor (16) as part of a motor assembly (15). A person having ordinary skill in the art would recognize the presence of a lamination stack in the motor because, contrary to the Examiner’s statements, it is an inherent and conventional component of an electric motor. In addition, a lamination stack in an electric motor is conventionally provided in approximately the same shape and location as the lamination stack now identified by numeral 19 in the drawings. A person of ordinary skill in the art, when viewing the drawings (Fig. 1) as filed, would have been able to easily and correctly identify the

lamination stack (19) as currently identified and described.

Support for the proposition that a person of ordinary skill in the art would recognize the lamination stack in the originally filed drawings can be found by reviewing issued U.S. patents, specifically those assigned to the assignee of record in this case, Ametek, Inc. A search of Ametek's issued patents reveals numerous patents dating back to at least 1990 that disclose inventions in the same field as the present invention and that positively identify and discuss a lamination stack. Those U.S. patents include Patent Nos. 7,394,975; 7,352,103; 7,102,266; 6,762,531; 6,756,713; 6,309,180; 6,037,688; 5,990,594; 5,760,505; 5,736,805; 5,734,214; 5,591,017; 5,313,129; and 5,108,199. Each of these patents discloses a stack of laminations, or lamination stack, positioned around the windings (17) of an electric motor, similar to the lamination stack (19) of the current invention.

The lamination stack was clearly shown in the drawings as filed, is an inherent component of an electric motor as described in the present application, and would have been recognized as such in the drawings by those skilled in the art. It is therefore respectfully submitted that the previous amendment to the specification did not constitute an addition of new matter under 35 U.S.C. § 132(a). With it being the Applicant's position that no new matter was added by the previously submitted amendment, removal of the objection under § 132(a) is respectfully requested.

Claims 1-5, 7-15, and 24 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More particularly, the Examiner states that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The rejection under 35 U.S.C. § 112, first paragraph, is based upon the introduction of the "lamination stack" limitations into claims 1 and 9 in the previously filed claim amendments. The Applicants respectfully request reconsideration of the claim rejections under 35 U.S.C. § 112 in view of the remarks made above regarding the objection to the previously submitted amendment as an introduction of new matter.

Claims 1-5, 7-9, and 24 have been rejected as unpatentable over the patent to Wentz, U.S. Patent No. 5,567,127 in view of the patent to Soltani et al., U.S. Patent No. 5,944,494, and further in view of the patent to Morimoto et al., U.S. Patent No. 5,219,648.

The remaining claims have also been rejected as being unpatentable over the aforementioned references and in further view of the patent to Finkenbinder et al., U.S. Patent No. 6,703,754; and U.S. Patent Publication No. 2004/0165986 to Parker et al. In rejecting all of the pending claims, the Office Action asserts that Soltani teaches a motor (80) substantially in contact with a foam shell (72, 74) in order to isolate vibrations of the motor. It is noted, however, that claim 1, as previously amended, calls for a motor assembly comprising an electric motor having a lamination stack and windings, and a self-extinguishing flame and noise suppression sleeve *in contact with one of said lamination stack and said windings*, and not a *motor substantially in contact with a foam shell*, as stated by the Examiner.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Last, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectations of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In regard to establishing a *prima facie* case of obviousness, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Recent case-law has further clarified the burden placed upon an Examiner in establishing a *prima facie* case of obviousness. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some *articulated reasoning* with some *rational underpinning* to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007).

It is respectfully submitted that the proffered combination of Wentz, Soltani and Morimoto does not teach all of the elements of the claimed invention and, specifically, the limitation regarding the sleeve being in touching contact with at least one of said *lamination stack* and said windings. The amendment to claim 1 narrows the scope of the claim in that it further specifies the contact point with the sleeve. In light of the Examiner's remarks in this and previous office actions, and upon review of Wentz, the Applicants submit that Wentz does not teach a sleeve in contact with a lamination stack of a motor assembly. Even if the leads are interpreted as a part of the motor assembly of Wentz, they cannot be considered the equivalent of a lamination stack. In addition, the Applicants submit that Soltani does not disclose a sleeve in contact with either a lamination stack or windings of a motor assembly because the foam shell disclosed therein surrounds, and is in contact with, a motor housing. Therefore, the combination of Wentz and Soltani with any of the additional references listed above fails to teach all of the elements of claim 1. With it being the position of the Applicants that claim 1 is allowable, it is submitted that all claims depending therefrom are likewise allowable.

It is also noted that the teachings of Wentz indicate that a noise absorption sleeve is always placed in a spaced apart relation with respect to the heat generating elements of a motor assembly (lamination stack and winding) to avoid thermally degrading the sleeve. The spaced-apart relationship or openings are required to ensure proper air flow through the motor assembly. Indeed, at column 5, lines 61-66 of Wentz, it is stated that the air flow is desired so as to allow for the heat generated by the motor to be included in the air flow. It is respectfully submitted that such a feature teaches away from the limitation of a sleeve contacting at least one of the electric motor and windings, rendering the reliance upon Wentz improper. Contact between the sleeve and at least one of the electric motor and windings would impede air flow and the sleeve would act as a heat sink, thus reducing the temperature of air and defeating the purpose of the teachings of Wentz. In contrast, by using a self-extinguishing flame and noise suppression sleeve that is in touching contact with at least one of the electric motor and windings, sufficient air flow and noise suppression can be obtained without the adjacent sleeve igniting.

While it is believed that claim 5 is allowable for the reasons stated above, the Applicants also believe that claim 5 is allowable on its own merit. Claim 5 calls for a sleeve having a cover hole therethrough and wherein said motor assembly extends through

said cover hole. The Examiner has not provided a specific indication of where any of the references disclose such a sleeve having a hole, and a motor assembly extending through the hole. After reviewing the cited references, the Applicants submit that the limitation of claim 5 is not taught by Wentz, or any of the other cited references.

It is noted that a new claim 24 was submitted previously which calls for a motor assembly as defined in claim 1, wherein said motor assembly is provided without a sensor to maintain the motor at a limited temperature. None of the references made of record teach or suggest a sleeve in touching contact with one of the lamination stack and winding and which is provided without a sensor to maintain the motor at a limited temperature. While new claim 24 has been rejected in view of Wentz, Soltani and Morimoto, no indication has been provided where the references make such a teaching. The Applicants respectfully request that the Examiner specify where the references teach or suggest a sleeve in touching contact with one of the lamination stack and winding and which is provided without a sensor to maintain the motor at a limited temperature.

Additionally, it is respectfully submitted that the Examiner's articulated reasoning regarding the motivation to combine the various references is insufficient to establish a *prima facie* case of obviousness. In each instance in which multiple references are relied upon in rejecting one or more claims the Examiner provides a motivation to combine by stating that it would have been obvious to include the additional feature due to the advantage of that feature as disclosed by the Applicants. There is no underlying rational to the Examiner's motivation to combine the various references other than the application of hindsight by relying upon the Applicant's identification of the advantages of the combination of the claim elements. Therefore, the Applicants believe that the Examiner has failed to properly establish a *prima facie* case of obviousness for any of the claim rejections under 35 U.S.C. § 103(a).

In view of the foregoing amendments and arguments presented herein, the Applicants believe that they have properly set forth the invention and accordingly, respectfully request the Examiner reconsider and withdraw the rejections provided in the last Office Action. A formal Notice of Allowance of claims 1-5, 7-15, and 24 is earnestly solicited.

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payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 18-0987. If a withdrawal is required from Deposit Account No. 18-0987, the undersigned Attorney respectfully requests that the Commissioner of Patents and Trademarks cite Attorney Docket Number **4570.94** for billing purposes.

Should the Examiner deem a telephone call to be beneficial in resolving any remaining matters, or to place the claims in better form for allowance, the same would be greatly appreciated.

Respectfully submitted,



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